

REMARKS

In the Office Action, the Examiner noted that Claims 1 through 8 were pending in the Application. The Examiner rejected all claims. Claims 1, 2, 4, 6, 7 and 8 have been amended, and Claims 1 - 8 remain pending in the Application. Applicants traverse the rejections below.

I. Traversal of the Rejection over 35 U.S.C. Section 112

Claims 1 through 8 were rejected under 35 U.S.C. Section 112, second paragraph, for being indefinite. The Office Action noted that "primary problems existed with respect to claims 4, 7, and 8....[h]owever, all of the claims are affected because the problem may exist with independent claims 1 and 6 as well..."

The Office Action goes on to state that the subject matter of claims 4, 7 and 8 is confusing with respect to the term 're-inserting'. Claims 4 and 7 have been amended to address this concern, but Claim 8 has not been so amended, as the term 're-inserting' was not used in Claim 8 as originally presented. Claim 8 states that the original document is recreated utilizing the stub document and the retrieved document. This seems to conform to the Examiner's concerns without amendment.

DE920000113US1

6

Other than Claims 4, 7 and 8, only Claim 2 was specifically addressed under this rejection. Applicants have amended Claim 2 to remove the negative limitation noted by the Examiner.

The remaining claims were not specifically addressed under this rejection, and have not been amended with respect to the comments contained in this portion of the Office Action. Applicants assert that in light of the clarification provided above with respect to Claims 4 and 7, that these claims conform to the requirements of 35 U.S.C. Section 112.

The Examiner's comments have been appreciated. Applicants submit that the claims are now in conformance with the requirements of 35 U.S.C. Section 112, second paragraph, and respectfully request withdrawal of the rejection.

II. Traversal of the Rejections over the Cited Art

The Examiner rejected Claims 1, 2, 4 and 6 - 8 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,216,165 to Woltz et al (Woltz). The Examiner rejected Claims 1, 3 and 5 under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent Publication 2002/0065892 A1 to Malik. Applicants traverse these rejections below.

DE920000113US1

7

A. The Present Invention

The present invention provides a technique for handling the off-loading of content from a document to a repository in a document processing system. A document in the system is copied to a remote repository. The document in the system is then stripped down to a stub document containing at least enough information to permit a user to identify the document as well as a link to the copy in the repository. If a user wants to view the document, the copy is retrieved from the repository, and the original document is recreated in the document processing system. This technique is effective in reducing the storage requirements of the document processing system itself by providing enhanced usage of a separate remote storage system.

B. Differences between the Claims and Woltz

Woltz discloses an e-mail paging system. In Woltz, a mail program receives an incoming email. As per Figure 6 and column 6, a copy of the message is archived. If the message includes an attachment, a copy is sent to e-mail, the attachment is stripped and an attachment notice added to the message, and the revised message is sent to a pager.

Claim 1 differs significantly from Woltz. In Woltz, the message is revised only if it contains

DE920000113US1

8

an attachment. The revised (or original if there was no attachment) message is then sent to a pager. The 'revised' message is not maintained in a document processing system. The revised message does not include information that permits retrieval of the copy from the repository. Rather, the full message is placed into e-mail. A copy of the full message is originally archived on the host computer prior to sending it to e-mail (the document repository system?) "for a limited period of time in the event that the e-mail message is received in the user's computer in a corrupted form." See Column 6, lines 24 - 48.

The Office Action also fails to identify exactly what from Woltz discloses the repository and the document processing system. The Office Action appears not to take this into consideration. As amended, Claim 1 recites that the stub document is maintained in the document processing system. In Woltz, the revised message is forwarded to a pager. There is no indication or teaching that the revised message is maintained anywhere. Further, Woltz does not disclose that selection of the revised message results in the automatic retrieval of the copy from a repository. In Woltz, a copy of the original message is maintained for a limited period of time at a host computer in case the message as delivered to email (not the pager) was corrupted. There is no use of a repository to minimize that amount of data stored in a document processing system, which is the goal of the present invention.

DE920000113US1

9

For these reasons, Applicants respectfully submit that Woltz does not teach, suggest or disclose the subject matter of independent Claim 1. Independent Claims 6 and 8 were rejected for the same reasons as Claim 1. Based on these arguments, Applicants submit that independent Claim 1, 6 and 8 patentably distinguish over Woltz. While it follows that the dependent claims also patentably distinguish therefrom, further differences between dependent Claim 4 and independent Claim 8 and Woltz are discussed below.

Claims 4 and 8 recite similar subject matter. Using Claim 4 for exemplary purposes, Claim 4 recites "retrieving the stored document from the repository when the user attempts to open the stub document." This subject matter is not addressed in the Office Action, and no allegation is made that Woltz discloses this subject matter. In fact, there is no retrieval of a message stored in a repository when the revised message in the pager is 'opened'. Further, no content is inserted into the stub document in Woltz. Accordingly, Applicants submit that Claims 4 and 8 further distinguish over Woltz.

C. Difference between the Claims and Malik

Malik discloses a system for minimizing storage of common attachment files in an e-mail communications server. The goal of Malik is to minimize the number of times a given attachment

DE920000113US1

10

is stored by enabling storage of a single copy of the attachment such that the single copy may be accessed by multiple e-mails that originally included the attachment. The Office Action used Malik to reject Claims 1, 3 and 5 as being obvious. In Malik, if an incoming email has an attachment, a check is made to determine the size of the attachment. If the attachment is larger than a threshold size, then the attachment is detached and an attachment subroutine is entered into. The subroutine determines if the attachment is already in an attachment database, and if so, then the attachment is not saved again in the attachment database. If not, the attachment is stored in the attachment database. In either case, a link is stored with the email header in a header database. The e-mail message itself may be stored in a separate message database.

Claim 1 recites the step of "storing a copy of an original document from the document processing system in the repository". Relative to this subject matter, the Office Action apparently states that Malik stores an attachment in a separate location but does not store a copy of the original document, but it "could very well be a copy of an original document". The second step of Claim 1 recites the step of "stripping content from the original document in the document processing system..." The detaching of the attachment in Malik is cited relative to this subject matter.

The analysis in the Office Action apparently boils down to Malik that the detaching of the attachment somehow teaches or suggests that one could make a copy of the original document and

DE920000113US1

11

store is separately, even though it is admitted in the Office Action that Malik does not do so and rather detaches the attachment. The Office Action goes on to suggest that the detaching of the attachment also teaches the subsequent step from Claim 1 of stripping content to form a stub document. So somehow the argument is that Malik, by removing an attachment from a document, teaches both (a) making a copy of a document and (b) subsequently stripping content from the document to form a stub document. Applicants submit that the single step of Malik does not teach, suggest or disclose the overall subject matter of Claim 1. Malik simply detaches attachments from e-mail. The heart of Malik is directed to managing the storage of attachments such that only a single copy of a given attachment is stored, that attachment being accessible by all e-mails that originally included that attachment. Malik simply does not teach, suggest or disclose making a copy of a document and storing it in a repository, and then stripping content from the original document to leave a stub document.

Accordingly, Applicants submit that Claim 1 patentably distinguishes over Malik. It follows that dependent Claims 3 and 5 also patentably distinguish therefrom.

III. Summary

Applicants have presented technical explanations and arguments fully supporting their

DE920000113US1

12

position that the pending claims contain subject matter which is not taught, suggested or disclosed by Woltz or Malik, and that the claims are now in conformance with the requirement of 35 U.S.C. Section 112. Accordingly, Applicants submit that the present Application is in a condition for Allowance. Reconsideration of the claims and a Notice of Allowance are earnestly solicited.

Respectfully submitted,



Gregory M. Doudnikoff
Attorney for Applicant
Reg. No. 32,847

GMD/lld

Docket No: DE920000113US1
PHONE: 919-254-1288 FAX: 919-254-4330

FAX RECEIVED
AUG 25 2003
GROUP 2100

OFFICIAL

DE920000113US1

13